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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|------------------------|---|
| Proceeding | 92054724 |
| Party | Defendant Can't Stop Productions Inc. |
| Correspondence Address | CAN'T STOP PRODUCTIONS INC. C/O MARCUM LLP, 750 THIRD AVENUE 11TH FLOOR NEW YORK, NY 10011 UNITED STATES |
| Submission | Motion to Dismiss - Rule 12(b) |
| Filer's Name | Jay A. Bondell |
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| Signature | /Jay A. Bondell/ |
| Date | 12/06/2011 |
| Attachments | Motion to Dismiss.pdf (35 pages)(1661388 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark Registration No. 3,821,800
For the mark VILLAGE PEOPLE
Date registered: July 20, 2010

KAREN L. WILLIS,

Petitioner,

v.

CAN'T STOP PRODUCTIONS, INC.,

Registrant.

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Cancellation No. 92054724

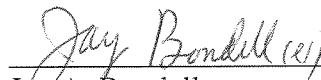
MOTION TO DISMISS

Pursuant to Rule 12(b) of the Federal Rules of Civil Procedure, Registrant Can't Stop Productions, Inc. ("Registrant") hereby moves for an order dismissing the proceeding. Registrant submits this Motion to Dismiss together with a Memorandum of Law in support of its motion.

Dated: December 6, 2011
New York, New York

Respectfully Submitted

LADAS & PARRY LLP



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In the matter of trademark Registration No. 3,821,800

For the mark VILLAGE PEOPLE

Date registered: July 20, 2010

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| KAREN L. WILLIS, | |) | |
| | |) | |
| | Petitioner, |) | |
| | |) | |
| v. | |) | Cancellation No. 92054724 |
| | |) | |
| CAN'T STOP PRODUCTIONS, INC., | |) | |
| | |) | |
| | Registrant. |) | |
| | |) | |
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**MEMORANDUM OF LAW IN SUPPORT OF
REGISTRANT'S MOTION TO DISMISS**

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INTRODUCTION

1. The Parties

Registrant is the owner of all trademark rights related to the VILLAGE PEOPLE musical group well known for its famous hits, including "Y.M.C.A", "Macho Man", and "In the Navy."

Petitioner is the wife and manager of one of the original members, Victor Willis, who permanently ceased to be a member of Village People in 1982. The current proceeding concerns the registration for Registrant's VILLAGE PEOPLE mark for compact discs featuring music and vocals and downloadable musical sound recordings.

2. Prior Cancellation Proceedings Between the Parties

In 2009 Petitioner instituted cancellation proceedings Nos. 92051212, 92051213, and 92051215 against registrations owned by Registrant. Cancellation Proceeding No. 92051212 is most relevant to the present proceeding, as it concerns Registrant's earlier registration for the identical mark for both identical and related goods. More specifically, Cancellation Proceeding No. 92051212 ("the '212 Proceeding") challenged Registration No. 2,184,290 ("the '290 Registration") for the mark VILLAGE PEOPLE for "pre-recorded phonograph records, audio cassettes, audio tapes and compact discs featuring music and vocals," in Class 9.¹

In the '212 Proceeding Petitioner asserted that the '290 Registration should be cancelled due to: (i) alleged instances of fraud by Registrant in prosecuting and maintaining the '290 Registration; (ii) alleged abandonment of the mark by Registrant; and (iii) alleged genericness of the mark. On September 22, 2011, in a consolidated opinion, the Trademark Trial and Appeal

¹ The other two proceedings involved Registrant's live entertainment services: Cancellation Proceeding No. 92051215 involved Reg. No. 1101013 for the VILLAGE PEOPLE mark for entertainment services rendered by a musical and vocal group, in Class 041; and Cancellation Proceeding No. 92051213 involved Reg. No. 2330857 for a multi-character design mark for entertainment services, namely, live performances by a musical and vocal group, in Class 041.

Board (the "Board") granted Registrant's motion for summary judgment on all of Petitioner's claims in Cancellation Proceeding Nos. 92051213 and 92051215, and granted Registrant's Motion for Summary Judgment on all of Petitioner's claims in Cancellation Proceeding No. 92051212 except for Petitioner's claim of abandonment.

With regard to Petitioner's claim of abandonment, the Board held that Registrant had shown continuous use of the mark VILLAGE PEOPLE for compact discs featuring music and vocals, and that the Petitioner did not dispute such use. See Exhibit A (Opinion dated September 22, 2011), p. 14. However, the Board held that there remained a genuine dispute of material fact as to whether Registrant has ceased using its mark in connection with "pre-recorded phonograph records, audio cassettes and audio tapes featuring music and vocals." Id. The Board also gave Petitioner a period of thirty days to submit a further amended Petition To Cancel which adequately pled a new fraud claim and/or non-use of the mark on certain of the other goods. Petitioner filed her "third amended petition to cancel" on October 21, 2011 which re-asserted her fraud claim based upon Registrant's allegations of use of the mark for "pre-recorded phonograph records, audio cassettes and audio tapes featuring music and vocals" made during the prosecution and maintenance of the '290 Registration.

3. The Subject Registration

On December 21, 2009, during the pendency of the cancellation proceedings between the parties, Registrant filed Trademark Application Serial No. 77/897,876 ("the '876 Application") under Section 1(a) for the mark VILLAGE PEOPLE for "compact discs featuring music and vocals; downloadable musical sound recordings," in Class 9. The '876 application was approved for publication on initial examination and was published for opposition on May 4, 2010. After

passing through the opposition period without objection the application issued as Reg. No. 3,821,800 on July 20, 2010 ("the '800 Registration").

Petitioner has subsequently filed the present cancellation proceeding seeking cancellation of the '800 Registration on the grounds of fraud and descriptiveness.

ARGUMENT

Dismissal under Rule 12(b)(6) is warranted if it is clear that a petitioner can prove no set of facts that would entitle petitioner to its claims for relief. *See Conley v. Gibson*, 355 U.S. 41 (1957). To survive a motion to dismiss, a complaint must contain sufficient factual matter, that if accepted as true, would state a claim to relief that is "plausible on its face". *See Bell Atlantic Corp. v. Twombly*, 550 U.S. 554 (2007).

As best understood, Petitioner's fraud claim presents three separate grounds. In a first prong of her fraud claim, Petitioner asserts that Registrant was precluded from directly "amending" the VILLAGE PEOPLE mark of the prior '290 Registration during the pendency of the '212 Cancellation Proceeding against it, because the amendment of a mark that is subject to a petition to cancel constitutes an inequitable act. Petition, ¶7. To overcome this obstacle, Registrant wrongfully and fraudulently filed the '876 Application, which filing "amounted to an amendment and/or disclaiming, in part, of a trademark under cancellation ... without consent of the opposing party, the TTAB or motion granted by the Board, in violation of section 2.133 of U.S. Trademark Law (sic)." Petition, ¶8.

Petitioner contends in a second prong of her fraud claim that, in connection with the filing and prosecution of the '876 Application, Registrant failed to disclose to the USPTO the pending 92051212 cancellation proceeding, which thus deprived the USPTO of material

information which would have "prevented new registration of the mark". The failure to make such disclosure was a fraudulent act.

In a third prong, Petitioner further contends that Registrant committed fraud by failing to inform the TTAB of the new '876 Application, filed in order to adversely effect or nullify any voiding of the mark in the '212 Cancellation Proceeding. Petition, ¶4.

A. Petitioner's Fraud Claim Should be Dismissed in Its Entirety

1. Petitioner's Fraud Claim Based Upon Failure To Inform the TTAB of the Filing of the '876 Application

As an initial matter, Petitioner's third prong can easily be disposed of and dismissed, as the allegation concerns a purported fraudulent omission made by Registrant in the '212 Cancellation Proceeding and thus is totally irrelevant to the present cancellation proceeding. It raises no claim of fraud in the prosecution of the application that issued as the '800 Registration. That aspect of the fraud claim must be dismissed as a matter of law.

2. Petitioner's Fraud Claim Based Upon Wrongful Filing of the '876 Application

Petitioner's claim that the filing of the '876 Application constituted fraud is wholly unsupported by existing law. Consequently, even if all of Petitioner's allegations were true with regard to this claim, Registrant's conduct could not be deemed a fraud on the USPTO.

Petitioner contends that the '876 Application amounted to an impermissible "amendment" of the '290 Registration. The scope of the '876 Application filed by Registrant is not identical to that of the '290 Registration. More specifically, the '876 Application does not include "pre-recorded phonograph records, audio cassettes and audio tapes featuring music and vocals" as are

recited in the '290 Registration, and includes "downloadable musical sound recordings" which are not covered by the '290 Registration. The USPTO recognizes that applications and registrations "with identifications that include some of the same goods/services, but also different goods/services, are not identical", TMEP §703, and provides no preclusion to such filings. If the '876 Application was identical to the '290 Registration, registration would have been refused. Id. Since the '876 Application is distinct from the '290 Registration, the prosecution of the '876 Application is not and cannot be deemed to be an impermissible "amendment" of the '290 Registration in any manner or respect, and thus its filing cannot constitute fraud.

Moreover, Petitioner misstates the rules concerning amendment of a registration subject to a petition to cancel. The filing of an amendment of a registration subject to a cancellation proceeding is itself permissible, and thus cannot qualify as an inequitable act. TBMP §514. The Rules provide that a registrant may amend a registration subject to a cancellation proceeding with the consent of the petitioner and a granted motion of the Board. Id. Alternatively, the Board may approve the amendment of a registration during a cancellation proceeding without the consent of the petitioner if the registrant consents to the entry of judgment on such goods. If a registrant files an unconsented motion to amend a registration subject to a cancellation proceeding and the registrant is unwilling to consent to judgment on the deleted goods, the amendment will be deferred until termination of the proceeding. Id.

In any event, a motion to amend a registration that is subject to a cancellation proceeding is permitted. Any such motion is considered and reviewed by the Board, and cannot escape scrutiny. Thus the filing of such a request to amend cannot by its mere filing be a fraudulent act. Accordingly, the portion of Petitioner's fraud claim alleging that the filing of the '876 Application constitutes an "impermissible" amendment of the '290 Registration must be

dismissed, as the allegations pled by Petitioner, even if proved, could not as a matter of law constitute a fraud on the USPTO.

3. Petitioner's Fraud Claim Based Upon Registrant's Failure to Inform the USPTO of the '212 Proceeding

Petitioner's claim of fraud based on Registrant's failure to inform the Examiner of the '212 Cancellation is subject to dismissal on two grounds, as follows.

a. Petitioner Fails to Plead the Fraud Claim with Sufficient Particularity

There is no authority that exists which holds that the failure to inform the Examiner of a cancellation proceeding constitutes fraud as a matter of law. A claim of fraud must be pled with sufficiently particularity in order to survive a motion to dismiss. Fed. R. Civ. P. 9(b); TBMP §309.03(c). Petitioner's pleading does not contain allegations which sufficiently point out her fraud claim, including the precise alleged misrepresentations or omissions that were made by the Registrant, or why the Examiner would have rejected the mark had Registrant not made the alleged misrepresentations or omissions. Accordingly, Registrant seeks dismissal of Registrant's claim of fraud on the grounds that Petitioner has failed to plead this claim with sufficient particularity.

Petitioner has failed to sufficiently plead the precise alleged misrepresentations or omissions that were made by the Registrant. It is unstated what Petitioner asserts that Registrant should have informed the Examiner concerning the pending cancellation proceeding (or when Registrant should have informed the Examiner of the pending cancellation). The '876 Application was approved for publication on initial examination. The Examiner did not reject the mark on genericness or descriptiveness grounds and did not request further information from Registrant.

Furthermore, Petitioner does not sufficiently allege facts which allege or explain how the cancellation proceeding is material to the '876 Application or why the Examiner would have rejected the application if Registrant had informed the Examiner of the cancellation proceeding.

Such omissions are fatal to this prong of Petitioner's fraud claim and require that it be dismissed for failing to plead fraud with sufficient particularity.

b. Petitioner's claim fails to state a claim upon which relief can be granted

Alternatively, even if the Board determines that Petitioner's claim for fraud based on Registrant's failure to inform the USPTO of the '212 Proceeding was pled with sufficient particularity, Registrant's failure to inform the USPTO of the '212 Proceeding cannot constitute fraud because it could not have been, and was not, a material omission by Registrant. In order to constitute fraud, any knowing misrepresentation or omission made to the USPTO during the prosecution of a trademark application must be material. *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969). A misrepresentation or omission is only material if the registration would not have issued had the truth been known to the examiner. *See McCarthy on Trademarks*, §31:66; *see also William Grant & Sons, Inc. v. National Distillers & Chemical Corp.*, 173 USPQ 813 (TTAB 1972).

Consideration of the Board's Opinion in the '212 Proceeding clearly shows that Registrant's failure to inform the USPTO of the '212 Proceeding could not have been a material omission or misrepresentation. The TTAB is entitled to view the Petitioner's claims asserted in the '212 Proceeding and the Opinion rendered by the Board in the '212 Proceeding in determining this motion, even though they may be facts outside the literal wording of Petitioner's pleading, because they are objective facts within the TTAB's records and are not

subject to a proof requirement in an *inter partes* proceeding. See TBMP §503.02 (facts not subject to proof may be considered when a party has filed a motion to dismiss).

In the Opinion, the Board granted Registrant's Motion for Summary Judgment on all of Petitioner's claims in the '212 Proceeding except for her claim of abandonment. The claim of abandonment was directed to "pre-recorded phonograph records, audio cassettes and audio tapes featuring music and vocals" which are not in the '876 Application. Furthermore, the potential additional claim re-plead by Petitioner in the '212 Proceeding (and awaiting review by the Board) is based on Registrant's conduct in prosecuting and maintaining the '290 Registration, and does not concern the '876 Application.

The only claim in the '212 Proceeding that could have had relevance to the registrability of the '876 Application is the alleged genericness of the mark. However, the genericness claim was dismissed by the Board on Registrant's motion for summary judgment on the basis that Petitioner:

has not, and apparently cannot, raise any genuine dispute of material fact with regard to this ground as petitioner has submitted no evidence, nor even made allegations, to show the term VILLAGE PEOPLE is used as a generic term for musical recordings or performances.

Opinion, p. 17.

Since the genericness claim was found meritless by the Board and dismissed as a matter of law, this claim could not have caused the Examiner to reject the '876 Application. Accordingly, the Registrant's failure to notify the Examiner of the existence of the '212 Proceeding could not have been a material omission and cannot constitute fraud.

B. Petitioner's Descriptiveness Claim Should be Dismissed as a Matter of Law

1. Petitioner's claim fails to allege facts that, if true, support a cognizable claim

The allegations of descriptiveness in the Petition to Cancel are in Paragraphs 16-18.

Paragraph 16 solely contains conclusory language that Village People is descriptive of Registrant's "products and services which it is used [sic]" and does not explain how the mark is descriptive. Paragraph 17 contains the only factual allegations by Petitioner which purport to describe how the Village People mark is descriptive of "compact discs featuring music and vocals and downloadable musical sound recordings."

A first allegation in ¶17 of the Petition is that the term "Village People" is descriptive because it describes musical sound recordings "by and attributable to people in a village." While Petitioner recites the alleged basis for the assertion that "village people" is descriptive of a type of sound recordings, Petitioner does not allege - nor could she properly allege - that the specific goods in question, i.e. Registrant's sound recordings and downloads, are in fact by or attributable to "people in a village". Therefore, Petitioner's claim based on the mark's describing music from people from a village must be dismissed for failure to assert a claim upon which relief can be granted.²

Petitioner also alleges in Paragraph 17 that Registrant's goods feature or are attributable to a group or type of people or characters found in Greenwich Village, NY and the mark is representative of people from Greenwich Village. This allegation, even if accepted as true, is insufficient for the mark VILLAGE PEOPLE to be descriptive of Registrant's musical sound

² This portion of Petitioner's claim is analogous to Petitioner's dismissed genericness claim in the '212 Cancellation Proceeding where the Board held that "[i]t is fallacious to allege that because a term is the generic name for one thing [people living in a community or small town], it cannot serve as the trademark for another thing [musical sound recordings]." Opinion, p. 16. Petitioner similarly fails to plead and is unable to prove that the Registrant's goods arise from or concern people in a village in any respect.

recordings. The alleged characteristics of the performers in the Village People musical group, whether they be individuals from Greenwich Village or somehow representative of people from that region, do not describe a characteristic, quality, or attribute of the musical sound recordings of the subject registration. Petitioner's allegation that the mark is descriptive of Registrant's performers is irrelevant to the present proceeding, which solely concerns Registrant's musical sound recordings in Class 9. Therefore, this allegation must likewise be dismissed as a matter of law.

2. Petitioner's claim is implausible on its face and must be dismissed

Alternatively, if the Board determines that Petitioner sufficiently pled her descriptiveness claim against Registrant's goods, Petitioner's allegation that the term VILLAGE PEOPLE for musical sound recordings merely describes goods arising from or related to people from Greenwich Village must be found to be implausible on its face, and thus subject to dismissal.

In *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554 (2007), the Supreme Court heightened the standard that a complaint must satisfy in order to survive a motion to dismiss. In *Twombly*, the Court held that a petitioner must allege facts which are sufficient to raise a claim that is plausible on its face. *Id.* A claim is plausible only if the factual allegations are sufficient to raise a right to relief above the speculative level and there is a reasonable expectation that discovery will reveal evidence supporting the claim. *Id.* at 556-557. Petitioner's claim of descriptiveness lacks plausability because it does not contain sufficient plausible factual allegations that raise the claim above mere speculation and accordingly should be dismissed as a matter of law.

To the extent Petitioner alleges that the mark is descriptive of a group or type of people or characters found in Greenwich Village, NY, this is actually a tacit acknowledgement that the

mark is a source identifier for Registrant's goods and services, not an allegation of descriptiveness of the music performed by the performers.

In 1977 Registrant created and formed a unique musical group performing under the mark VILLAGE PEOPLE which featured performers in six costumes each representing an iconic American character; an Indian, a cowboy, a biker, a construction worker, a military man, and a policeman. Such an assemblage was unprecedented in the musical industry, and has remained unique, instantly recognizable as being associated with Registrant's Village People group. The iconic American characters stereotypes were chosen based at least partly on their perceived appeal to homosexual men. The band name VILLAGE PEOPLE adopted by Registrant may well allude to Greenwich Village, which was known for its large homosexual population at the time of the formation of the group.

The VILLAGE PEOPLE mark as it relates to musical sound recordings, however, has no instantly recognizable meaning or significance, except as a source indicator for Registrant's goods. If an average American consumer was completely unaware of Registrant's goods and services, it is self evident that such consumer would not reach the conclusion that "Village People" describes music or people from Greenwich Village. The only way that an average American consumer would readily conclude that "Village People" describes people from Greenwich Village when viewing Registrant's mark would be if they were already familiar with Registrant's VILLAGE PEOPLE service mark for its live musical performances and the attendant secondary meaning. And a determination that Village People somehow describes the performers of the music does not establish that the music itself is of a "village people" genre or describe Registrant's musical sound recordings in any other manner.

Petitioner has offered no allegations as to why “village people” would be considered descriptive of music “from a village” or what the characteristics of such village people are and how Registrant’s recordings and downloads somehow possess such a characteristic. Accordingly, Petitioner's pleading fails to provide sufficient plausible allegations to make her descriptiveness claim survive a motion to dismiss. *See Bell Atlantic v. Twombly*, 127 S. Ct. at 1965. Petitioner's pleading fails to allege enough facts to raise a reasonable expectation that discovery will reveal evidence in support of her claim. In fact, there is no evidence available to establish that the VILLAGE PEOPLE mark has a common understood meaning or significance for Registrant's goods aside from being a source identifier for Registrant's goods and services.³ Therefore, Petitioner's claim should be dismissed.

CONCLUSION

For the foregoing reasons, Petitioner's Petition should be dismissed in its entirety.

Dated: December 6, 2011
New York, New York

Respectfully Submitted

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³ It is noted that the Board found in the '212 Cancellation Proceeding that Petitioner did not submit any evidence to show that the term VILLAGE PEOPLE is used as a generic term for musical recordings or performances.

CERTIFICATE OF SERVICE

It is hereby certified that on December 6, 2011, a true copy of the foregoing Motion to Dismiss is being served by first-class mail, postage prepaid, to the Petitioner, Karen L. Willis, at the following address:

Karen L. Willis
P.O. Box 1022
La Jolla, CA 92038

By: 
Elliot Lipins

EXHIBIT A

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed:

September 22, 2011

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Cancellation No. 92051212
Cancellation No. 92051213
Cancellation No. 92051215

Karen L. Willis

v.

Can't Stop Productions, Inc.

Before Seeherman, Walters and Taylor,
Administrative Trademark Judges.

By the Board:

Petitioner, the wife and manager of a former member of the musical recording group the Village People, has filed amended petitions for cancellation¹ of respondent's three

¹ In Cancellation No. 92051212 petitioner filed a first amended petition to cancel on July 21, 2009, and a second amended petition to cancel on August 11, 2009. Respondent appears to have filed its answer as to the second amended petition to cancel. The proper procedure would have been for petitioner to file a motion to amend the petition to cancel with her second amended petition, or to file it with respondent's consent. See Fed. R. Civ. P. 15(a)(2). In view of respondent's answer, it appears that respondent has consented to the amendment of the pleading, and therefore we have accepted the second amended petition to cancel and respondent's answer thereto. However, petitioner is reminded that strict compliance with the rules is required in the future. We also note that petitioner has created some confusion by alleging damage in the original and amended petitions to cancel from two registrations, Nos. 1101013 and 2184290, although the petition to cancel filed in this proceeding relates only to Registration No. 2184290, and Registration No. 1101013 is the subject of Cancellation No. 92051213. To clarify, the Board deems the petition to cancel in Cancellation No. 92051212 as relating solely to Registration No. 2184290.

Cancellation Nos. 92051212, 92051213 and 92051215

registrations: two registrations are for the typed word mark, VILLAGE PEOPLE,² and one is for the design mark shown below:



This case now comes up for consideration of respondent's motions for summary judgment on petitioner's pleaded grounds of fraud, abandonment and genericness in each of the three cancellation proceedings.

I. Single Order

While there is no motion to consolidate these proceedings pending, Fed. R. Civ. P. 42(a), as made applicable to Board proceedings by 37 CFR Section 2.116(a) (Trademark Rule 2.116(a)), provides that when actions involving common questions of law and fact are pending before the Board, the Board may order all of the actions consolidated, and it may make any orders concerning

² Registration No. 1101013, issued August 29, 1978, for "entertainment services rendered by a musical and vocal group" in Class 41, based on an application filed November 17, 1977 and asserting dates of first use and first use in commerce of July 11, 1977.

Registration No. 2184290, issued August 25, 1998, for "pre-recorded phonograph records, audio cassettes, audio tapes and compact discs featuring music and vocals" in Class 9, based on an application filed November 17, 1993 and asserting dates of first use and first use in commerce of 1978; goods in class 16 were cancelled pursuant to § 8 of the Trademark Act in 2008.

³ Registration No. 2330857, issued March 21, 2000, for "entertainment services, namely, live performances by a musical and vocal group" in Class 41, based on an application filed April 3, 1998, and asserting dates of first use and first use in commerce of July 11, 1977.

Cancellation Nos. 92051212, 92051213 and 92051215

proceedings to avoid unnecessary costs or delay. In this case there is sufficient commonality of factual and legal issues in the proceedings that consolidation for consideration of the summary judgment motions is appropriate. All three cancellation proceedings involve the same parties and contain very similar pleadings. However, because Cancellation Nos. 92051213 and 92051215 are disposed of by this order, as explained more fully below, consolidation is unnecessary beyond the issuance of this single order applicable to all three proceedings.

II. Sufficiency of Pleadings

A decision on summary judgment necessarily requires a review of the operative pleadings of these three cases. *See, e.g., Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1478 (TTAB 2009). Therefore, we start by noting that the petitions do not properly plead claims of fraud.

The Court of Appeals for the Federal Circuit has held that a trademark registration is obtained, or maintained, fraudulently only if the respondent knowingly makes a false, material representation with the intent to deceive the USPTO. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009). Under Fed. R. Civ. P. 9(b), any allegations of fraud based upon "information and belief" must be accompanied by a statement of facts upon which the

Cancellation Nos. 92051212, 92051213 and 92051215

belief is founded. See *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 91 USPQ2d 1656, 1670 n.7 (Fed. Cir. 2009); *Meckatzer Lowenbrau Benedikt Weiss KG v. White LLC*, 95 USPQ2d 1185 (TTAB 2010).

In order to properly plead a claim of fraud in a trademark cancellation proceeding, a petitioner must allege with particularity that the respondent knowingly made a false, material misrepresentation when applying for a trademark registration, or when renewing a registration, with intent to deceive the USPTO. *Enbridge Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009). It is the preferred practice of the Board that the element of intent be pled specifically, but intent, as a condition of mind of a person, may be averred generally. Fed. R. Civ. P. 9(b); see also *DaimlerChrysler Corp. v. American Motors Corp.*, 94 USPQ2d 1086, 1089 (TTAB 2010) (finding allegations of material misrepresentations knowingly made to procure a registration constitute sufficient allegation of intent element for pleading fraud).

Petitioner bases her claims of fraud on various theories that require some construction and which we summarize as follows: 1) respondent provided false dates of first use in its applications either in the application as originally filed or in a statement of use; 2) the marks have not been in use in commerce since the original Village People group disbanded and respondent's post-registration filings continued this fraud

Cancellation Nos. 92051212, 92051213 and 92051215

regarding dates of use; 3) the marks misrepresent the source of the goods because the Village People group disbanded about 1982; and 4) various claims relating to the nature of respondent's services, as discussed more fully below. To the extent petitioner considers each of these claims to allege a particular type of fraud, we consider them each in turn.

1. Dates of Use in the Applications/Statement of Use

Petitioner alleges in her amended petitions for cancellation that the dates of first use claimed in the applications which resulted in issuance of respondent's registrations, namely, July 11, 1977 in Registration Nos. 1101013 and 2330857, and 1978 in Registration No. 2184290, were false.

With regard to Registration Nos. 1101013 and 2330857, for the mark VILLAGE PEOPLE and the design mark for entertainment services rendered by a musical and vocal group, petitioner argues that the only member of the "group" as of the July 11, 1977 claimed date of first use was petitioner's husband, who was accompanied by professional background singers. To the extent petitioner is alleging that the date of use is false or inaccurate because her husband only performed with background singers as of the claimed date of first use and did not perform with others who would later become known as members of the Village People group until after July 11, 1997, we do not find this distinction to state a claim of fraud.

Cancellation Nos. 92051212, 92051213 and 92051215

With regard to Registration No. 2184290, also for the mark VILLAGE PEOPLE, but for various types of recordings, petitioner essentially argues that the first musical album was recorded in July 1977, not 1978. This claim also fails to state a claim of fraud because the dates of first use alleged by an applicant in a use-based application or statement of use filed in an intent-to-use application, even if false, do not constitute fraud, as long as there was technical trademark use on or before the filing date of the application or statement of use. Clearly, petitioner contends that there was use prior to the filing date of November 17, 1993.

With respect to the design mark shown in Registration No. 2330857 for entertainment services, the application was filed on April 3, 1998, and claimed a date of first use of July 11, 1977. Petitioner alleges, however, that the earliest date the mark could have been used was 1979, because all of the characters represented in the mark did not exist until that time, and the appearance of the characters changed over time. This claim, too, does not state a claim of fraud, because by petitioner's own reckoning, all the characters represented in the mark were part of the group by the time the application was filed. Again, a claim of fraud based on assertion of a false date of first use will not lie unless there is no use of the mark on or before the filing date.

Cancellation Nos. 92051212, 92051213 and 92051215

Respondent contends that petitioner has not adequately alleged that the marks were not in use as of the filing dates of the applications or statements of use, submits further evidence of its claimed dates of use, and argues that, as a matter of law, there is no proper pleading of claims of fraud regarding the dates of use. We agree.

In view thereof, petitioner's fraud claims based on allegedly false dates of first use are stricken.

2. Non-use as of the Post Registration Filing Dates

Petitioner alleges that respondent was not using the marks on the filing dates of the respective Section 8 and 15 declarations, and the declarations filed in the Section 9 renewal applications, because the specimens submitted with the post registration declarations were not in continuous use for the five years immediately preceding the filing of the declarations. We construe these as claims of fraud for non-use. Fraud based on non-use of a mark occurs when a party knowingly, and with the intent to deceive the USPTO, represents that it is using the mark in connection with goods or services, when in fact no use of the mark has been made. *Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc.*, 86 USPQ2d 1572 (TTAB 2008).

Specimens of use need only illustrate current use of the mark at the time of filing the Section 8 and 15 declarations and the application for renewal. In fact, a declaration of continuing use filed pursuant to Section 8 does not require

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that the mark be in use for the five years preceding the filing of the declaration, only that the mark be in use at the time the declaration is executed. The same is true of the application for renewal. Even for a Section 15 declaration, which asserts five years of continuous use, there is no requirement that the *same* specimen be used for those five years, only that the mark be in use for five continuous years prior to the filing of the declaration. To the extent petitioner is claiming fraud on these grounds, petitioner simply misunderstands the law.⁴ In view thereof, petitioner's fraud claims based on allegations that the specimens were not in use at the time of the post registration filings are stricken as insufficient.

3. Misrepresentation of Source

A claim of misrepresentation of source under Section 14(3) is a separate claim from fraud, and has not been separately pleaded by petitioner. It pertains to situations where a registered mark is used to deliberately misrepresent that goods or services originate from the registrant when in fact those goods or services originate from the petitioner. A pleading of misrepresentation of source must include allegations of blatant misuse of the mark by the registrant in a manner calculated to

⁴ Petitioner concedes that the use made by respondent's licensee Universal Music and Video Distribution inures to respondent's benefit and, in her opposing brief in Cancellation No. 92051212, withdraws her reliance on the claim that use was made by respondent's licensee, rather than by respondent.

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trade on the goodwill and reputation of the petitioner. *Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007). Petitioner's allegations fall short of these requirements. In view thereof, to the extent petitioner bases her fraud claims on alleged misrepresentation of source, the claims are insufficient both as fraud claims and as separate misrepresentation of source claims, and are stricken.

4. Nature of the Services

Petitioner makes various claims regarding the nature of respondent's services, including, the Village People is not a "musical and vocal group" but a "concept group;"⁵ the design mark does not depict petitioner's husband, Victor Willis; subsequent groups did not include petitioner's husband as a member or performer; and the group members lip-sync when performing and this constitutes "Milli Vanilli fraud." The Board's jurisdiction is limited to the registrability of trademarks, and none of these claims constitutes a legally cognizable trademark claim within the Board's jurisdiction.

5. Requirements for Adequate Fraud Pleading

Petitioner's claims recite that "upon information and belief" fraud has been committed, but these claims are largely devoid of any facts upon which the alleged belief can be reasonably based. Further, petitioner has not alleged fraud

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with the required particularity. It is only upon review of the declarations of petitioner and her husband, Victor Willis, attached to petitioner's papers opposing respondent's motion for summary judgment, that we discern a possible claim, but the claim is not adequately pleaded. With respect to Registration No. 2184290, that possible claim is non-use of the mark VILLAGE PEOPLE as of the underlying application filing date of November 17, 1993, and non-use of the mark as of the date of execution of all subsequent declarations of continued use, on pre-recorded phonograph records, audio cassettes and audio tapes featuring music and vocals.

We emphasize that, for the reasons set out above, petitioner has not properly pleaded any claim of fraud, but we nonetheless note that respondent has not presented evidence in support of its motion for summary judgment that would entirely preclude proper potential pleading by petitioner of non-use claims, and possibly a fraud claim based on allegations of non-use. While respondent has presented evidence of use on pre-recorded phonograph records for the years 1977-1982, there is no evidence offered that the mark was used beyond that date for those goods.

Therefore, petitioner's claims of fraud are legally insufficient and are hereby stricken from the pleadings.

⁵ To the extent petitioner intends this as a claim of abandonment for the identified services, the claim is addressed below in the section on abandonment.

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However, petitioner may, if appropriate, submit an amended petition to cancel asserting proper claims of non-use and/or fraud in Cancellation No. 92051212 only.

In view thereof, petitioner may, within **THIRTY DAYS** from the mailing date of this order, submit a third amended petition to cancel in Cancellation No. 92051212 which adequately pleads fraud and/or non-use.

We turn now to the claims of abandonment and genericness argued in respondent's motions for summary judgment as to all three cases.

III. Summary Judgment

Summary judgment is appropriate when there is no genuine dispute as to any material fact and the moving party is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(a). A party moving for summary judgment has the initial burden of demonstrating the absence of evidence to support the nonmoving party's case, and that it is entitled to judgment as a matter of law. *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1795-1796 (Fed. Cir. 1987), citing *Celotex Corp. v. Catrett*, 477 U.S. 317, 325, 106 S.Ct. 2548, 2554 (1986). When the moving party has supported its motion with sufficient evidence which, if unopposed, indicates there is no genuine dispute of material fact, the burden then shifts to the non-moving party to demonstrate the existence of a genuine dispute as

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to a material fact to be resolved at trial. *Enbridge*, 92 USPQ2d at 1540. A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See, *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

A trademark registration more than five years old may be canceled at any time if, inter alia, the mark becomes generic or is abandoned, or if the registration was obtained through fraud. See 15 U.S.C. § 1064.

A. Abandonment

Petitioner makes similar allegations regarding abandonment of all three of the registered marks, namely that since the 1980's the marks have only been licensed for live performances and no new recordings have been made since 1985; that the mark is for a "concept group," not a musical group; and that changes have been made to the design mark because of changes to certain of the characters depicted in the mark. Petitioner alleges that these changes amount to abandonment of all three marks without an intent to resume use.

Under Section 45 of the Trademark Act, a mark is deemed abandoned if its use has been discontinued without intent to

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resume use, and nonuse in the United States for a period of three consecutive years establishes a *prima facie* case of abandonment. See 15 U.S.C. § 1127. Thus, in order to prove abandonment, petitioner must be able to show that respondent's use of the mark has been discontinued for at least three consecutive years, or that respondent has discontinued use of the mark without an intent to resume use. *Id.*; see also, *On-Line Careline, Inc. v. America Online, Inc.*, 229 F.3d 1080, 1087, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000). Conversely, respondent, as the party moving for summary judgment dismissing the claims of abandonment, must establish continuous use of its marks for all of the goods and services named in the registrations, or that it has not ceased use without an intent to resume use. Respondent provides declarations from its managing director, Henri Belolo, declaring that Can't Stop Productions has offered pre-recorded musical recordings since 1977 and they are currently distributed, and that it has continually owned and used the marks with entertainment services since 1977. Also provided were the declarations of Mitchell Weiss, the manager of respondent's licensee, declaring that the licensed marks include VILLAGE PEOPLE and the design mark, and the marks have been continuously used by the licensee for over twenty years for musical performances. Attached to these declarations is evidence in the form of exhibits to

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show that the three marks have continuously been used and are still in use.

We must view respondent's motion for summary judgment on abandonment in a light most favorable to petitioner as the non-moving party. With regard to Registration No. 2184290, petitioner pleads that respondent cannot be offering recordings because the group has made no new recordings since the 1980's, and the mark has been licensed only for live performances since that time. Respondent has presented declarations and exhibits showing that compact discs have been continuously sold up to the present time, and petitioner does not dispute that point. Respondent has not shown, however, that it is still using the mark in connection with pre-recorded phonograph records, audio cassettes and audio tapes featuring music and vocals. At the least there is a genuine dispute of material fact as to whether respondent has ceased using its mark in connection with those goods. Accordingly, respondent's motion for summary judgment is denied in Cancellation No. 92051212.

With regard to Registration Nos. 1101013 and 2330857 for entertainment services, petitioner's arguments revolve around whether the performing group is a "real" musical and vocal group, or a "concept group," but petitioner does not allege or even argue that no performances are taking place. Petitioner presents her own declarations that she has seen

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the group perform, taking issue with the manner of performance, not the fact of it.⁶ Respondent has submitted magazine and internet advertisements, supported by the declaration of Mitchell Weiss, showing that the mark VILLAGE PEOPLE and the design mark have been used in connection with musical performances in 1994, 1995, 1997, 1998, 2001, 2002, 2003, 2004, 2005, 2006, 2008 and 2010. Further, respondent has asserted that use has been continuous, as evidenced by the Belolo and Weiss declarations. Whether or not petitioner believes there is a distinction between a "real" musical and vocal group and a concept group, petitioner has not raised a genuine dispute that the performances by respondent's group are not the rendering of performances by a musical and vocal group. Accordingly, there is no genuine dispute that respondent has used its marks for entertainment services in commerce without any gap of three years of non-use, and prima facie evidence of abandonment therefore does not exist. Accordingly, respondent's motions for summary judgment on the grounds of abandonment are granted in Cancellation Nos. 92051213 and 92051215.

B. Genericness

⁶ The Board notes that petitioner filed two additional declarations in Cancellation No. 92051213 because of an alleged scanning and upload error in the e-filing of a declaration signed by Victor Willis in that proceeding. Respondent filed an objection to the filing as untimely. Under the circumstances of this case, where an essentially identical declaration was filed in the other two cancellation proceedings, the Board grants the

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Although respondent has brought a motion for summary judgment regarding petitioner's genericness claims, in actuality respondent is arguing that this ground should be dismissed. Petitioner alleges in all three cases that the mark is generic because it identifies people in a village, and provides evidence attached to her response briefs to show the term VILLAGE PEOPLE is used to describe groups of people living in a community or small town. Respondent argues that petitioner does not allege that there are any other users of the mark for musical recordings or entertainment services, and provides evidence, supported by the Belolo declaration, that it has been the exclusive user of the VILLAGE PEOPLE marks in connection with musical recordings and performances for a significant period of time.

We note first that petitioner's allegations cannot apply to the design mark shown in Registration No. 2330857, because the words "Village People" do not appear in the mark.

A term is generic if it is the common descriptive name for a genus of goods or services, and should be refused registration because it does not function as a trademark or service mark. *Park' N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985). But a term can be a generic

motion to amend to the extent that the corrected declaration of

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term in one context and arbitrary or fanciful in another, and thus serve as a valid trademark when used as a mark for goods or services in another context. It is fallacious to allege that because a term is the generic name for one thing, it cannot serve as the trademark for another thing. See, e.g., *Eurotech, Inc. v. Cosmos European Travels Aktiengesellschaft*, 213 F.Supp.2d 612, 620, (E.D. Va. 2002) (rejecting as fallacious the argument that because COSMOS is generic for universe, it cannot serve as a trademark for travel agency services); see also 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:1 (4th ed. WESTLAW Update Aug. 2011).

We find that petitioner has not, and apparently cannot, raise any genuine dispute of material fact with regard to this ground as petitioner has submitted no evidence, nor even made allegations, to show the term VILLAGE PEOPLE is used as a generic term for musical recordings or performances. Accordingly, summary judgment is granted with respect to the ground of genericness in all three proceedings.

IV. Summary

In summary, respondent's motions for summary judgment are granted on petitioner's claims of abandonment in Cancellation Nos. 92051213 and 92051215, and as to

Victor Willis is substituted in Cancellation No. 92051213.

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genericness in all three proceedings. Because there are no properly pleaded fraud or non-use claims in Cancellation Nos. 92051213 and 92051215, and there do not appear to be any such viable claims against Registration Nos. 1101013 and 2330857 in those proceedings, summary judgment on the grounds of abandonment and genericness in those proceedings are a final disposition of the cases. Accordingly, Cancellation Nos. 92051213 and 92051215 are dismissed with prejudice.⁷

V. Schedule

Within **THIRTY (30) DAYS** of the mailing date of this order petitioner may submit a third amended petition to cancel in Cancellation No. 92051212 which adequately pleads fraud and/or non-use of certain goods, failing which the cancellation proceeding will go forward solely on the issue of abandonment. In the event petitioner files and serves such an amended petition for cancellation, the Board will

⁷ Because this is a final decision of the Board, the decision as to Cancellation Nos. 92051213 and 92051215 may be appealed to the Court of Appeals for the Federal Circuit or to a U.S. District Court with appropriate jurisdiction. See Trademark Act Sections 21(a)(1) and 21(b)(1), 15 U.S.C. §§ 1071(a)(1) and 1071(b)(1); Trademark Rule 2.145, 37 C.F.R. § 2.145; and TBMP § 901.01 (3d ed. 2011). The decision in Cancellation No. 92051212 is interlocutory in nature, therefore, any appeal thereof can be raised only after final disposition of that proceeding. See *Copeland's Enterprises Inc. v. CNV Inc.*, 12 USPQ2d 1562 (Fed. Cir. 1989).

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assess the sufficiency of those pleadings and reset answer dates, if appropriate.⁸

Proceedings in Cancellation No. 92051212 are resumed and dates are reset as set out below.

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|---|------------|
| Expert Disclosures Due | 10/27/2011 |
| Discovery Closes | 11/26/2011 |
| Plaintiff's Pretrial Disclosures Due | 1/10/2012 |
| Plaintiff's 30-day Trial Period Ends | 2/24/2012 |
| Defendant's Pretrial Disclosures Due | 3/10/2012 |
| Defendant's 30-day Trial Period Ends | 4/24/2012 |
| Plaintiff's Rebuttal Disclosures Due | 5/9/2012 |
| Plaintiff's 15-day Rebuttal Period Ends | 6/8/2012 |

⁸ The parties should note that the evidence submitted in connection with the motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See, *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). The parties may, however, stipulate that any or all of the summary judgment evidence be treated as properly of record for purposes of final decision. See, e.g., *Eveready Battery Co., Inc. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial pursuant to Accelerated Case Resolution (ACR)); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial).